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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,433

10/06/2005

Remy Tanimura

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OLIFF & BERRIDGE, PLC  
P.O. BOX 320850  
ALEXANDRIA, VA 22320-4850

EXAMINER

MAI, HAO D

ART UNIT

PAPER NUMBER

3732

MAIL DATE

DELIVERY MODE

05/19/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,433	<b>Applicant(s)</b> TANIMURA, REMY	
	<b>Examiner</b> HAO D. MAI	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

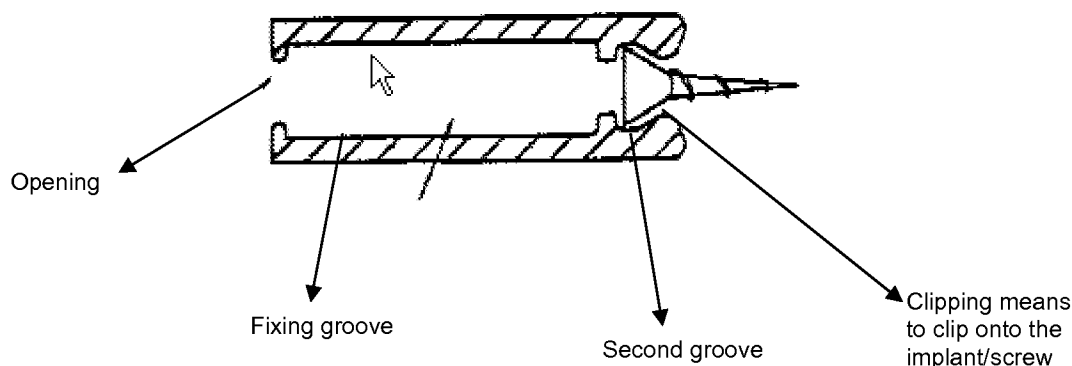
A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-7, 13, and 15-16, are rejected under 35 U.S.C. 102(b) as being anticipated by Gambale (6328746 B1).**

Gambale discloses a device and method capable of reversible fixing of a tool to an end of an implantable element, when fitting a dental prosthesis, where the device includes a hollow intermediate connecting part/cartridge 100 comprising: fixing means of annular lip 122 and a fixing groove (Figs. 3-4; see annotated Figure below) for fixing the hollow intermediate connecting part 100 in reversible manner onto an external complementary part of a tool/screw driver 20 (Figs. 2a, 4)); and clipping means (shown in annotated Figure below) designed to clip onto an external complementary part of a implantable element/screw 17. The fixing groove is shown to be delimited by rim/annular lip 133 arranged at one end of the hollow intermediate connect part 100; a second groove is shown to cooperate with an external rib formed at the end of the implantable element 17 (see Figure below). Hollow intermediate connecting part 100 is disclosed be made out of plastic (column 3 lines 20-25); and includes an opening passing through the surface at both ends for receiving the tool and the implantable element (see annotated Figure below). Screw 17 is capable of being a dental implant; screw driver tool 20 is capable of being a placing tool. The method of reversibly fixing the hollow intermediate connecting part 100 onto an external complementary part of the tool 20 and positioning the tool

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on the end of the implantable element is also disclosed (column 7 lines 21-24). Such method is also naturally and inherently carried out when using the invention as disclosed by Gambale.



**3. Claims 1-2, and 8-17, are (further) rejected under 35 U.S.C. 102(b) as being anticipated by Gervais et al. (7160109 B2).**

Gervais et al. teach of a device and method for reversible fixing of a tool to an end of an implantable element, when fitting a dental prosthesis, where the device includes a hollow intermediate connecting part/fixture mount 14 comprising: fixing means of clip 15 and groove 21 for fixing drive tool 18 in reversible/releasable manner onto an external complementary part of the tool 18 (Figs. 1, 4; column 6 lines 47-50); and clipping means of shoulder 51 which is capable of clipping onto the external complementary part of an implantable element 16/12 (Fig. 1). The hollow intermediate connecting part 14 is further disclosed to be made of plastic and/or metal (column 16 lines 31-34), and comprising paralleling slots/openings 148 allowing the hollow intermediate connecting part 14 to be deformable (Fig. 10; column 3 lines 50-56; column 13 lines 1-10). These slots are shown in alternative embodiments to be T-shaped slots 120 (Fig. 8) or oblique slots 138 (Fig. 9). The hollow intermediate connecting part 14 further includes spigots/splines 64 salient towards the inside of the hollow intermediate connecting part

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14 (Fig. 2). The implantable element 16/12 is disclosed to be a dental implant 12; the drive tool 18 is capable of placing the implantable element; the drive tool 18 is capable of being a transfer part (column 11 lines 31-34). The method of reversibly fixing the hollow intermediate connecting part 100 onto an external complementary part of the tool 20 and positioning the tool on the end of the implantable element is naturally and inherently carried out when using the invention as disclosed by Gervais et al.

### ***Response to Arguments***

4. Applicant's arguments filed 10/12/2007, with respect to rejections of claims 1-17 have been fully considered but are not persuasive. In response to applicant's argument that Gambale is a nonanalogous art as the screw 17 is not an implantable element for a dental prosthesis, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the reference is reasonable pertinent to the particular problem with which applicant is concern – "a method for reversible fixing of a tool to an end of an implantable element" Gambale is directed to a bone screw which is also implanted in the bones. The Office upholds that Gambale's screw 17 is capable of being an implantable element for a dental prosthesis. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. The fact that applicant found another use for the device does not make it consequently patentable. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

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Regarding applicant's arguments concerning Gambale does not disclose a method that includes the successive steps as claimed, note that it is Gambale's invention is capable of fixing the hollow intermediate connecting part/cartridge 100 onto the tool/screw driver 50 before fixing the cartridge 100 onto the screw 17. If the prior art shows capability of the claimed function(s), then it meets the required limitations recited by such functions. Furthermore, it was held that the order of performing process steps does not support patentability in the absence of new or unexpected results. *Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959). Regarding applicant's arguments that the connecting part/cartridge 100 and the screw 17 disclosed by Gambale do not complement one another as claimed, the examiner disagrees. Figures 3, 4, and the annotated Figure above of Gambale, clearly show the cartridge 100 clips onto the external complementary part of the screw 17. Gambale also discloses that screw 17 rests up against annular lip 133 of cartridge 100 when in preloaded position (column 5 lines 37-38).

Regarding applicant's arguments that Gervais's drive tool 18 is not fixed to the end of the implantable element as claimed, note that the implant comprises structures 12 and 16; and Figure 1 shows the drive tool 18 being fixed to the end 17 of the implant 12/16.

Applicant did provide proper arguments as to why claims 2-17 are patentable over Gambale or Gervais. Note that applicant has made amendments to the claims and that claims 2-17 no longer depend on claim 1.

### **Conclusion**

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO D. MAI whose telephone number is (571)270-3002. The examiner can normally be reached on Monday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Hao D Mai/  
Examiner, Art Unit 3732**

**/Cris L. Rodriguez/  
Supervisory Patent Examiner, Art Unit 3732**